

identical invention must be shown in as complete detail as is contained in the ... claim." MPEP §2131, citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Millevolte reference fails this exacting standard for the claims of the present application.

Millevolte discloses a postcard enclosing a floppy disk or CD-ROM, the postcard picture being stored as a panoramic picture that can be manipulated by a PC mouse. The postcard itself is disclosed to be a cardboard box (2) to house a conforming cardboard package (3) that acts as a casing for the CD-ROM. The cardboard package consists of a center section (3a) upon which two tabs (3b, 3b), two strips (3c, 3c), and two wings (3d, 3d) are folded in upon themselves as shown in FIGs 3-6 and described in the associated text. The cardboard package (3) is then inserted into the cardboard box (2) as shown in FIG. 7. Examiner has called Applicant's attention to element (3) in the Figures and col. 1, line 50 to col. 2, line 2; col. 2 line 49 to col. 3, line 30 as disclosing a medial filler laminated to and spacing apart a first lamina.

Claims 1 and 13 require that there be a medial filler and that the medial filler be laminated to and spacing apart first and second lamina. Millevolte does not disclose or teach such a laminated medial filler. Millevolte discloses "an approximately parallelepiped shaped thin cardboard box without sides...the front surface of this case would consist of the actual photographic image...A conforming cardboard package to house the floppy disk or CO-ROM is fitted in the cardboard box through opening on its sides." Col. 1, line 51 - col. 2, line 2. This conforming cardboard package "consists of a section of prepunched cardboard with several folding lines" (col. 2, lines 45-46) that enable wings (3d), two strips (3c), and two tabs (3b) to be folded inward towards the center section (3a) as described. Col. 3, lines 3-22. Note first that there is no teaching of a medial filler that spaces apart a first lamina "having an image disposed thereon" (Millevolte uses a separate cardboard carton (2) upon which is printed an image (1)). Second there is no teaching that the medial filler be "laminated to" the first lamina. The conventional definition of laminate is to "bond to one or more thin layers". See, for example, Webster's New World Dictionary, Simon & Schuster, 1982. Applicant's specification is consistent with this definition. See page 13, lines 1-7. Millevolte discloses a folding of tabs, etc. without lamination. Since an anticipation rejection

requires the presence in the cited reference of all of the elements of a claimed invention arranged as in the claims and since the Millevolte reference does not disclose or teach at least two of the elements of Applicant's claimed invention, the anticipation rejection of independent claims 1 and 13 based upon Millevolte is improper.

Claims 2-7, 15-19, and 21 are dependent claims dependent upon independent claims 1 and 13, respectively. Since claims 1 and 13 are believed allowable, claims 2-7, 15-19, and 21 are believed allowable. Special notice should be given to claims 5, 6, 18, and 19, however.

Claims 5 and 18 require that there be a second user specified computer file comprising a video file compliant with a video standard. Millevolte discloses an image stored as a 3D panoramic image that can be manipulated by a PC mouse and that the image is of much better quality than that illustrated on the postcard. See col. 1, lines 22-30. Examiner has called Applicant's attention to the fact that Millevolte has used the words "PC video screen" (col. 1, line 24) and draws the conclusion that this means that the video file is compliant with a video standard. Applicant respectfully disagrees that because an image can be reproduced on a PC monitor screen, the file itself is compliant with a *video standard*. Moreover, video standards are applicable to concatenated sequences of pictures ("video" is conventionally defined as "of or related to television" - see, Webster's New World Dictionary, Simon & Schuster, 1982). Applicant identified conventional *video standards* at page 2, lines 21-27 that are consistent with the conventional understanding of the word video. Therefore, Millevolte does not disclose a second computer file and Millevolte does not disclose that such a second file would comply with a *video standard*. In addition to being dependent upon presumed allowable independent claims, claims 5 and 18 introduce limitations that are not anticipated by Millevolte.

Claims 6 and 19 require that there be a linking between the image file and the video file. There must be two files, an image file and a video file. Applicant respectfully disagrees with Examiner's interpretation that a printed picture is a "computer file" (see antecedent in claim 3). Moreover, the mere fact that the image printed on Millevolte's outer carton is the product of a printing of a computer file is insufficient to teach a linking between the video file and the image file. Accordingly, Millevolte does not disclose or

teach the existence of two computer files, one image and one video, so there cannot be a teaching of a linking of the two files. Therefore claims 6 and 19 additionally are not anticipated by Millevolte.

Examiner has rejected claims 8-11 under 35 U.S.C. 103(a) as being unpatentable over USP 5,825,996 to Davis et al. ("Davis") in view of Digital Photo & Video Maker disclosed at the URL: [www.dazzle.com/products/photo\\_gut.html](http://www.dazzle.com/products/photo_gut.html) ("Dazzle 1"). Examiner has not formally identified the date of publication of this webpage reference. Applicant respectfully requests a corrected copy of PTO-892 and that a copy of this reference be formally introduced into the record. Applicant appreciates the faxed copy of this reference sent to Applicant on May 8, 2006.

A rejection under §103(a) requires that "...the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains..." 35 U.S.C. 103(a). The investigation of obviousness has been well defined in Graham v. Deere, 383 U.S. 1, 148 USPQ 459 (1966). Three factual inquiries are to be made when performing analysis under §103: 1) the scope and content of the prior art are to be determined; 2) the differences between the prior art and the claimed invention are to be ascertained; and 3) the level of ordinary skill in the pertinent art is to be resolved. In the present rejection, the rejection is based upon two references. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). If limitations found in Appellants' claims are simply not found in the references, alone or in combination, Examiner has not met the burden of a showing of a

*prima facie* case of obviousness and the §103 rejection is improper. Examiner has not met this burden.

Davis discloses a method and apparatus for printing greeting cards, invitations, and the like completely to the edge of the printed medium. A memory device (20) is connected with a personal computer system (2) and accepts a removable storage medium, memory disk (42), for storing a graphical image creating means (46), a size determining means (48), and a printer actuating means (50). "The graphical image creating means is appropriately encoded on the memory substrate 42 and adapted to communicate with the operating system program 22 to receive control information from user input into the personal computer system 2. The graphical image creating means 46 then creates with the personal computer system 2 a graphical image to be printed onto principally the primary printable area of the substrate 24 of the print medium 14 but also to some extent across the perforated line 26 and in the secondary print area as described above. The graphical image creating means can be used to create one or more images for printing on one or more sides of the print medium 14." Col. 8, lines 52-63.

Dazzle 1 discloses a product that captures video and still images, enables the editing of videos and still images, and enables the creation of video CDs and office presentations.

Claim 8 requires that the processor accept still image content and video content and create a first digital image file suitable for storing, a second digital image file suitable for printing, and a video file. Further, claim 8 requires that there be a data recorder that records the first image file and the video file on the personalized storage medium. In accomplishing the first and second Deere tests, we consider the scope and content of the cited prior art. As shown above, Davis simply does not teach, disclose, or suggest the accepting or storing of a first image file and a video file on a storage medium since Davis is concerned with edge to edge greeting card printing. Dazzle 1 is a still image/video capture and video CD burner product; Dazzle 1 does not teach, disclose, or suggest the packaging of the newly-burned CD or the storage of a video file and first and second digital image files, one of which digital image files is suitable for printing an image on the packaging. Even when advantageously combined as Examiner has suggested, the teachings, disclosure, and suggestions of the two references do not indicate a printing of

the second digital image file on the packaging. Even if the advertisement of potential uses for Davis includes postcards, there is no explicit or implicit teaching, suggestion, or motivation in the cited references to make packaging for the CD with an image stored as a file on the CD as proposed by the Examiner. Accordingly, the obviousness rejection of claim 8 based upon Davis and/or Dazzle 1 is improper.

Claims 9-11 are dependent claims dependent upon claim 8. Since claim 8 is believed allowable, claim 9-11 are believed allowable.

Examiner has rejected claims 8 and 12 under 35 U.S.C. 103(a) as being unpatentable over Davis in view of EmMe disclosed at the URL: [www.dazzle.com/products/emme\\_gut.html](http://www.dazzle.com/products/emme_gut.html) ("Dazzle 2"). Examiner has not formally identified the date of publication of this webpage reference. Applicant respectfully requests a corrected copy of PTO-892 and that a copy of this reference be formally introduced into the record. Applicant appreciates the faxed copy of this reference sent to Applicant on May 8, 2006.

The disclosure and teachings of Davis have been reviewed above. Dazzle 2 is a USB video connector product that in combination with other Microsoft Windows products enables a user to store (for example, on CD ROMS), manage, edit, and share movie clips, digital pictures, and audio files.

Claim 8 requires that the processor accept still image content and video content and create a first digital image file suitable for storing, a second digital image file suitable for printing, and a video file. Further, claim 8 requires that there be a data recorder that records the first image file and the video file on the personalized storage medium. In accomplishing the first and second Deere tests, we consider the scope and content of the cited prior art. As shown above, Davis simply does not teach, disclose, or suggest the accepting or storing of a first image file and a video file on a storage medium since Davis is concerned with edge to edge greeting card printing. Dazzle 2, in conjunction with other products, enables the capture of still images and/or video and the burning of these files onto a CD; Dazzle 2 does not teach, disclose, or suggest the packaging of the newly-burned CD or the storage of a video file and first and second digital image files, one of which digital image files is suitable for printing an image on the packaging. Even when advantageously combined as Examiner has suggested, the teachings, disclosure, and

suggestions of the two references do not indicate a printing of the second digital image file on the packaging. However, there is no explicit or implicit teaching, suggestion, or motivation in the cited references to make packaging for the CD with an image stored as a file on the CD as proposed by the Examiner. Accordingly, the obviousness rejection of claim 8 based upon Davis and/or Dazzle 2 is improper.

Claim 12 requires an audio processor that accepts audio content input and creates a digital audio file for storing. Dazzle 2 states: "Once you have your *video* on your PC, you can ... store, manage, edit and share ... audio files." Key features include the ability to "...add background music and voice-over narration with ... *video* editing software." The plain teaching of Dazzle 2 is that the audio is conventionally associated with video content; not stored as a digital audio file. Claim 12 is dependent upon independent claim 8, which is believed to be allowable. Additionally, claim 12 has been shown to be allowable over Dazzle 2. Accordingly, the obviousness rejection of claim 12 based upon Davis and/or Dazzle 2 is improper.

Examiner has rejected claim 14 under 35 U.S.C. 103(a) as being unpatentable over Millevolte in view of USP 5,909,373 to Sansone et al. ("Sansone"). Sansone discloses a kiosk that dispenses postal franking on mail for user payment through a currency receiving slot. Sansone also includes a printer (31) for printing reports for the owner of the kiosk (col. 3, lines 61-62) and a dot matrix printer to fill in the postal value for the user of the kiosk (col. 1, lines 18-21). Neither of the printers are shown to print user-desired images as stated. (Claim 14 is dependent upon claim 13 which requires the "creating of a personalized storage medium and packaging ... [by] printing an image related to said stored *user specified* computer file on a first outward facing surface..."). Even when Sansone and Millevolte are advantageously combined (assuming such combination proper), Applicant's claimed invention is not disclosed or suggested because the proposed combination does not have the filler laminated between the first and second surfaces (see the above argument related to claim 13) and the proposed combination does not have a payment for the storage medium and its packaging. Therefore claim 14 has not been shown to be obvious in view of Millevolte and Sansone.

Examiner has rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over Millevolte in view of Official Notice. Examiner notes that Millevolte does not

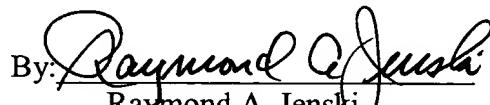
specifically disclose the storing of a second user specified computer file as a digital audio file but that images are reproduced upon a PC video screen. However, Examiner gives Official Notice that it is well known to store audio and video together. While it may be known that audio and video may be stored together as an MPEG file (or other video standard), Applicant contends that separate (i.e., "user specified image file" (claim 16) and "second user specified computer file" (claim 20)) associated audio and video files, as claimed in claim 20 are not known. For this reason in combination with the fact that claim 20 is ultimately dependent upon a believed allowable independent claim 13, claim 20 is believed allowable.

In summary, neither Millevolte nor Dazzle 1 nor Dazzle 2 nor Davis nor Sansone, taken alone or in the proposed combinations, teach or suggest the invention as now claimed. Accordingly, a rejection of the claims under 35 U.S.C.102(b) or 35 U.S.C.103(a) is not proper for the reasons given above. Therefore, in view of the foregoing, Applicant believes the present Application to now be in a condition suitable for allowance. Examiner is respectfully urged to withdraw the rejections and pass the present Application to allowance. In the alternative, Examiner is respectfully urged to enter the present Amendment as placing the present Application in a better condition for appeal.

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